

REMARKS/ARGUMENTS

The abstract has been amended to remove reference numerals.

Claim Rejections – 35 USC 103***Claim 1***

5 In sections 3 and 4 of the Office Action, the Examiner rejected Claim 1 under 35
USC 103(a) as being unpatentable over Himmelstein et al. (U.S. Publication No.
2001/0011270 A1), herein referred to as the Himmelstein publication, in view of
Asmussen et al. (U.S. Publication No. 2002/0042923 A1), herein referred to as the
Asmussen publication. Specifically, the Examiner stated that the combination of the
10 Himmelstein and Asmussen publications teach all of the elements of Claim 1. The
Applicants respectfully disagree.

First, the Applicants note that the Asmussen publication was filed on August 3,
2001. The Applicants' application was filed on April 13, 2001 which was before the
filing of the Asmussen publication. Therefore, the Applicants believe that the Asmussen
15 publication cannot be used as prior art against the Applicants' pending patent application.
35 USC §102 states, "A person shall be entitled to a patent unless – (b) the invention was
patented or described in a printed publication in this or a foreign country or in public use
or on sale in this country, more than one year prior to the date of the application for
patent in the United States, or ... (e) the invention was described in – (1) an application
20 for patent, published under section 122(b), by another filed in the United States before the
invention by the applicant for patent." The Applicants submit that since the filing date of
the Asmussen publication is after the filing date of the Applicants' application, it is not
possible for the Asmussen publication to meet the statutory requirements of 35 USC §102
and thus the Asmussen publication cannot be used to reject the claims in the present
25 application.

Further, the Applicants submit that the combination of the Himmelstein and
Asmussen publications do not teach all of the elements of Claim 1. As noted by MPEP
2143.03 to establish a *prima facie* case of obviousness, all the claim limitations must be
taught or suggested by the prior art. Specifically, the Applicants assert that neither the
30 Himmelstein publication nor the Asmussen publication teaches, discloses, or suggests

“said reasoning element is configured to use a set of rules to extract metadata from the files” and “said reasoning element provides an output of metadata.”

Claim 1 claims, in part, “said reasoning element is configured to use a set of rules to extract metadata from the files” and “said reasoning element provides an output of metadata.” On page 3 of the Office Action, the Examiner admitted that the Himmelstein publication does not teach these two elements. However, on page 4 of the Office Action, the Examiner stated that the first element is taught in reference numeral 339 of Figure 6b, and paragraph 0021 of the Asmussen publication, and the second element is taught in paragraphs 0028 and 0059 of the Asmussen publication. The Applicants respectfully disagree.

Figure 6b of the Asmussen publication is a block diagram of the Suggestion Keyword Indexer 310, and the Rule-Based Tagging Algorithm 339 is located within the Suggestion Keyword Indexer 310. As stated in paragraph 0021 of the Asmussen publication, “an apparatus for suggesting available content in a digital communications network comprises a content metadata crawler that searches ... and produces a metadata list, wherein the metadata list comprises a plurality of metadata elements ...” Thus, the Applicants submit that the Asmussen publication teaches that the metadata crawler, not the Suggestion Keyword Indexer, is the element that produces the metadata.

Further, paragraph 0069 of the Asmussen publication describes the operation of the stochastic part-of-speech tagging algorithm 339. Paragraph 0069 states, “The classifying module 325 may include computational linguistics tools, such as a rule-based part-of-speech tagging algorithm 337 and a stochastic part-of-speech tagging algorithm 339. The classifying module 325 uses the computational linguistic tools to determine part-of-speech data of a word item.” Further, in paragraph 0067 the Asmussen publication teaches, “A comparison module 327 coupled to the classifying module 325 may compare word items to a set of database entries to determine a list of related items.” Thus, the Applicants submit that the Asmussen publication is teaching using database entries to determine a list of related items or to determine the part-of-speech data of a word item, but not for extracting the metadata from the file, as, discussed earlier, the metadata crawler produces a metadata list. Thus, the Asmussen publication does not teach, disclose or suggest, “said reasoning element is configured to use a set of rules to extract

metadata from the files” and “said reasoning element provides an output of metadata,” as is claimed in Claim 1. Therefore, the Applicants submit that Claim 1 is patentable over the combination of the Asmussen publication and the Himmelstein publication.

Further, the Applicants submit that the combination of the Asmussen publication with the Himmelstein publication is improper. MPEP 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination,” citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Further, “obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art,” MPEP 2143.01, citing *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Finally, “the showing [of obviousness] must be clear and particular,” *In re Dembiczak*, 50 USPQ2d 1614, 1616-1617 (Fed. Cir. 1999). The Applicants submit that the Himmelstein publication and the Asmussen publication together with the knowledge generally available to one of ordinary skill do not establish a *prima facie* case of obviousness.

In the Office Action, the Examiner asserted, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of the Himmelstein publication by the teachings of the Asmussen publication to include said reasoning element is configured to use a set of rules to extract metadata from the files and said reasoning element provides an output of metadata because it creates reduced processing power and more efficient data retrieval results. The Applicants submit that the motivation to combine the references is from the Applicants’ disclosure and not from any knowledge found in either the prior art or in one skilled in the art at the time of the invention.

The Himmelstein publication uses spatial information, see abstract of the Himmelstein publication, to achieve more efficient data retrieval results. The Applicants assert that there is no teaching in either the Himmelstein publication, the Asmussen publication, or in the knowledge of one of ordinary skilled in the art at the time of the invention, to change the spatial information scheme of the Himmelstein publication to a scheme of using a set of rules to extract metadata. Further, while the Himmelstein

publication is directed toward text searching of documents, see abstract of the Himmelstein publication, the Asmussen publication is directed toward providing suggestions depending on an input by the user, see abstract of the Asmussen publication. The Applicants are unaware where in the prior art or in the knowledge of one of ordinary skill in the art the Examiner has found the motivation to combine these references. If the Examiner disagrees with the Applicants, the Applicants respectfully request that the Examiner provide additional information as to where the motivation to combine these references is found. Therefore, for all of the reasons given above, the Applicants submit that Claim 1 is patentable over the cited prior art.

Claims 2-8

Claims 2-8 are dependent upon Claim 1. For the reasons given above, the Applicants submit Claim 1 is patentable over the cited prior art. Therefore, the Applicants submit that Claims 2-8 are also patentable over the cited prior art at least through their dependency on an allowable base claim.

Claims 9-16

Claim 9 is similar to Claim 1 in that Claim 9 claims, “using a set of rules in said reasoning element to extract metadata from the files” and “providing an output of metadata from said reasoning element.” Therefore, the same arguments presented above in support of Claim 1 may also be applied to Claim 9. Therefore, the Applicants submit that Claim 9 is also patentable over the cited prior art.

Claims 10-16 are dependent upon Claim 9. As previously mentioned, the Applicants submit that Claim 9 is patentable over the cited prior art. Therefore, the Applicants submit that Claims 10-16 are also patentable over the cited prior art at least through their dependency upon an allowable base claim.

Concluding Remarks:


In view of the foregoing, it is respectfully submitted that all now pending Claims 1-16 are in allowable condition. Reconsideration is respectfully requested. Accordingly, early allowance and issuance of this application is respectfully requested. Should the Examiner have any questions regarding this response or need any additional information, please contact the undersigned at (310) 589-8158.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 50-2691. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 50-2691.

Respectfully submitted,

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